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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,221	08/19/2002	Sunao Takatori	2222.6090001	9612
26111 7590 02/21/2008 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER LE, CANH	
			ART UNIT 2139	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/070,221

Applicant(s)

TAKATORI ET AL.

Examiner

Canh Le

Art Unit

2139

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This Office Action is in response to the application filed on 12/06/2007.

Claims 1-10 have been cancelled.

Claims 11-21 have been added.

Claims 11-21 have been examined and are pending.

### *Response to Amendment*

The amendment filed 12/06/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has not shown support in the specification for the added material in the amendment.

Applicant is required to cancel the new matter in the reply to this Office Action.

Some new matters can be found as the following pages of a new amended specification.

Page 2, par. [0006], "**query information**" in lines 3, 7;

Page 8, par. [0038], "**query information**" in lines 1-2, 6;

Page 8, par. [0041], "**query information**" in line 1;

Page 8, par. [0042], "**query information**" in lines 1, 8;

Page 9, par. [0045], "**query information**" in line 5;

Page 12, par. [0053], "**query information**" in lines 6-7.

A **query information** has different meaning than "**collation information**".

Page 12, par. [0052], "However, **a confirmation after the fact is made** regarding the second communication terminal PD2 " in lines 2-3" has different meaning than "However, **a prior confirmation is executed** to the second communication terminal PD2".

Page 16, par. [0071], "**unique signals**" in line 5 has different meaning than "**intrinsic signal**".

### ***Response to Arguments***

Applicant's arguments filed 12/16/2007 have been fully considered but they are not persuasive.

**With regard to claims 11 and 21**, The Applicant argues that:

"Schuichi, Taro and Schunichi fail to teach or suggest a host computer "transmitting to a mobile communication device a request for user identification information in response to receiving the query information from the service device", as recited claims 11 and 21.

The Examiner respectfully disagrees with the applicant and still maintains that Taro teaches a host computer transmitting to a user device a request for user identification information in response to receiving the query information from the service device (**See Taro; par. [0012]**).

Taro does not explicitly disclose user terminal is a mobile communication device. However, Schuichi teaches a mobile communication device which transmits a user ID to

a host communication device to a demand (**See Schuichi; par. [003]; fig. 1, a communication terminal is a mobile device 100**).

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Taro of the invention by including the step of Schuichi because it would allow a provider to perform user authentication by distinguishing whether the transmitted password is a password corresponding to the user ID transmitted previously [**Schuichi, par. [0003]**]. Please, See more details in the Office Action below.

Claim 21 has similar limitations as claim 11 and rejected with same argument above.

**With regard to claim 17**, The Applicant argues that

"Similar to claim 11 and 21, Independent claim 17 recites features that distinguish over the applied references. For example, claim 17 recites a host computer that includes "a transmitter operable to transmit a request for the user identification information to the mobile communication device in response to receiving the query information from the service device, and further operable to transmit authentication information, to the service device, based on comparison results." As noted above in regards to similar distinguishing features recited in claims 11 and 21, Schuichi, Taro, and Schunichi, alone or in combination, fail to teach or suggest this distinguishing feature of claim 17."

The Examiner respectfully disagrees with the applicant and still maintains that

Claim 17 has similar limitation as claim 11. Taro further discloses a transmitter operable to transmit a request for the user identification information to the mobile communication device in response to receiving the query information from the service device, and further operable to transmit authentication information, to the service device, based on comparison results (**See Taro, par. [0012] ; par. [0078]**). Please, see more details in the Office Action below.

Therefore, the Examiner asserts that cited prior does teach or suggest the subject matter recited claims 11-21.

The fact that Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative should not be construed as indicating Examiner's agreement therewith.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 11 and 21** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 11 recites "**query information**" in lines 2 and 4 which was not disclosed in the original specification.

Claim 21 recites "**query information**" in lines 3 and 5 which was not disclosed in the original specification.

Even though it is new matter, the prior art still reads on this new limitation. Please, see more details in the Office Action below.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 17 and 21** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "The authorization of a user" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the limitation "The authentication of the user" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 11, 12, 17, and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fukuo Taro** (JP 2000-76336) in view of **Fukai Shuichi et al.** (JP 2000-92236).

**As per claim 11**

Taro teaches a method for authentication of a user using a host computer, comprising:

(a) receiving query information from a service device regarding the authentication of the user [par. [0024], **“The electronic banking authorization system 1-7 receives each authentication request demand from two or more Electronic Commerce Technology Division service provider equipment 1-6. It has the function to perform authentication for electronic banking alone about a user, and functions as an authentication center intensively prepared to two or more Electronic Commerce Technology Division service providers”; Electronic Commerce Technology Division service provider is equivalent to service equipment**];

(b) transmitting to a user communications device a request for user identification information in response to receiving the query information from the service device [par. [0012]; **“A means to \*\*\*\*\* a user terminal through a public network based on this user identifier, and to receive the secrecy information of the user for electronic banking directly through this public network from a user terminal”**];

(c) receiving the user identification information from the user communications



device [par. [0012]; “A means to \*\*\*\*\* a user terminal through a public network based on this user identifier, and to receive the secrecy information of the user for electronic banking directly through this public network from a user terminal”];

(d) comparing the user identification information and authentication information to generate comparison results [par. [0078]; “Furthermore, in order that an electronic banking authorization system may perform his identification by calling back the Electronic Commerce Technology Division service user based on the subscriber information memorized by the database storage section, the Electronic Commerce Technology Division service provider side and the user side -- him -- necessity of the special authentication equipment for identification cannot be carried out, but simple composition can perform his identification, and trouble generating of an unjust claim of the charge by a user's malpractice etc. can be prevented”]; and

(e) using the comparison result for the authentication of the user [par. [0078]]. Taro teaches limitations in claim 11. Taro does not explicitly disclose user terminal is a mobile communications device.

However, Schuichi teaches a mobile communication device which transmits a user ID to a host communications devices to a demand [par. [003]; “A communication terminal transmits a user ID to a provider to the demand. A provider will demand transmission of a password from a communication terminal next, if a user ID checks that it is regular ID. A communication terminal transmits a password to

**the demand. And a provider performs user authentication by distinguishing whether the transmitted password is a password corresponding to the user ID transmitted previously”; fig. 1, a communication terminal is a mobile device 100].**

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Taro of the invention by including the step of Schuichi because it would allow a provider performs user authentication by distinguishing whether the transmitted password is a password corresponding to the user ID transmitted previously **[Schuichi, par. [0003]]**.

#### **As per claim 12**

Schuichi further teaches the method of claim 11, wherein the user identification information includes personal attributes of the user **[par. [003]; “A communication terminal transmits a user ID to a provider to the demand. A provider will demand transmission of a password from a communication terminal next, if a user ID checks that it is regular ID. A communication terminal transmits a password to the demand. And a provider performs user authentication by distinguishing whether the transmitted password is a password corresponding to the user ID transmitted previously”; fig. 1, a communication terminal is a mobile device 100].**

#### **As per claim 17**

This claim consists a host computer for implementing an authorization process to implement claim 11 and storage device **[Shuichi ; par. [0014], “moreover, / said**

**electronic banking authorization system / section / which memorizes the subscriber information of the user who registered with this electronic banking authorization system beforehand, and the Electronic Commerce Technology Division service provider / subscriber database storage] It has the transaction database storage section which memorizes the order data of Electronic Commerce Technology Division sent and received between a user terminal and Electronic Commerce Technology Division service provider equipment”]; thus it is rejected with the same rationale applied against claim 11 above.**

**As per claim 21**

This claim consists a computer-readable medium containing instructions or controlling at least one processor of a host computer to implement claim 11; thus it is rejected with the same rationale applied against claim 11 above.

**Claims 13-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fukuo Taro** (JP 2000-76336) and **Fukai Shuichi et al.** (JP 2000-92236) in view of **Watanabe Schunichi** (JP 06-215009).

**As per claim 13**

The combination of Taro and Schuichi teach the subject matter as described in claim 11.

Taro and Schuichi do not explicitly teach about receiving from the service device information regarding current services provided.

However, Schuinichi teaches about receiving from the service device information regarding current services provided [par. [005]; **“The purpose of this invention memorizes cumulatively the amount of money for purchase in a unit period for every card number of each card issuer. When the amount of money for purchase memorized about the credit card shown at the time of processing of transactions exceeds the purchase limit set up beforehand, it is in offering the card processing system which can prevent that buy it and unjust dealings of the large sums by the surroundings are performed by transmitting that to a card issuer”**].

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Taro and Schuichi of the invention by including the step of Schunichi because it would allow a card processing system which can prevent that buy it and unjust dealings of the large sums by the surroundings are performed by transmitting that to a card issuer **[Schunichi, par. [005]]**.

**As per claim 14**

Schunichi further teaches the method of claim 13, further comprising selecting an authentication level for the authentication according to the information regarding the current services provided [claim 1, claim 2; par. [005]; **“The purpose of this invention memorizes cumulatively the amount of money for purchase in a unit period for every card number of each card issuer. When the amount of money for**

**purchase memorized about the credit card shown at the time of processing of transactions exceeds the purchase limit set up beforehand, it is in offering the card processing system which can prevent that buy it and unjust dealings of the large sums by the surroundings are performed by transmitting that to a card issuer”; authentication level can be amount of money purchases exceeding the limit setup beforehand].**

**As per claim 15**

Schunichi further teaches the method of claim 14, wherein the authentication level is selected based on a comparison between past service provision history and the information regarding the current services provided [par. [005]; **“The purpose of this invention memorizes cumulatively the amount of money for purchase in a unit period for every card number of each card issuer. When the amount of money for purchase memorized about the credit card shown at the time of processing of transactions exceeds the purchase limit set up beforehand, it is in offering the card processing system which can prevent that buy it and unjust dealings of the large sums by the surroundings are performed by transmitting that to a card issuer”].**

**As per claim 16**

Schunichi further teaches the method of claim 14, wherein the authentication level is selected based on at least one of cost of service, services provision area,

service provision frequency, and total sum of money for the services provided [**claim 1, claim 2; par. [005]; “The purpose of this invention memorizes cumulatively the amount of money for purchase in a unit period for every card number of each card issuer. When the amount of money for purchase memorized about the credit card shown at the time of processing of transactions exceeds the purchase limit set up beforehand, it is in offering the card processing system which can prevent that buy it and unjust dealings of the large sums by the surroundings are performed by transmitting that to a card issuer”].**

**Claims 18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fukai Shuichi et al.** (JP 2000-92236) and further in view of **Fukuo Taro** (JP 2000-76336).

**As per claim 18**

Schuichi teaches A communications device, comprising:

(a) a receiver operable to receive, from a host computer, a request for information regarding authentication of a user [**par. [003]; “the provider of whom connection was required demands transmission of a user ID from a communication terminal first. A communication terminal transmits a user ID to a provider to the demand”];**

(b) a storage device operable to store information regarding the authentication of the user [**par. [003]; “A communication terminal transmits a user ID to a provider**

**to the demand”; It is inherent that communication terminal stores user ID in a memory before transmitting user ID to a provider]; and**

(c) a transmitter operable to transmit information regarding the authentication of the user, stored in the storage device, to the host computer in response to receiving the request for information regarding the authentication of the user [par. [006]-[007];

**“Moreover, invention according to claim 9 data in the information service equipment which transmits through a communication line to the attested communication terminal [connection request / from said communication terminal]**

**It is characterized by having a terminal specific information receiving means to receive the terminal specific information which specifies the communication terminal concerned, and the authentication means which attests whether said connection request is recognized based on said terminal specific information which received”];**

(d) wherein the communications device is a mobile communication device [fig. 1, box 100; par. [0010], cellular phone and land mobile radiotelephone].

Schuichi teaches limitations in claim 18. Schuichi does not explicitly disclose a request for information regarding authentication of a user at a service device.

However, Taro discloses a request for information regarding authentication of a user at a service device [par. [0024], “The electronic banking authorization system 1-7 receives each authentication request demand from two or more Electronic Commerce Technology Division service provider equipment 1-6. It has the function to perform authentication for electronic banking alone about a user, and

**functions as an authentication center intensively prepared to two or more Electronic Commerce Technology Division service providers”; Electronic Commerce Technology Division service provider is equivalent to service equipment].**

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to combine the communication device of Schuichi of the invention by including the step of Taro because it would allow the electronic banking authentication system which can perform electronic commerce, and electronic commerce service provider equipment safely in the electronic commerce service by the Internet, without preventing leakage of secrecy information, such as a credit card number, and being able to perform maintenance and check of electronic data, and the user registering secrecy information, such as a credit card number, beforehand **[Taro, par. [0011]].**

**As per claim 19**

Schuichi further teaches the communications device of claim 18, wherein the transmitter is further operable to selectively transmit, to the host computer, information regarding the authentication of the user based on a type of authentication requested **[par. [003]; “A provider will demand transmission of a password from a communication terminal next, if a user ID checks that it is regular ID. A communication terminal transmits a password to the demand. And a provider**



**performs user authentication by distinguishing whether the transmitted password is a password corresponding to the user ID transmitted previously”].**

**As per claim 20**

This claim consists a computer program product comprising a computer useable medium including control logic stored therein, the control logic enabling a communications device to implement claims 18-19; thus it is rejected with the same rationale applied against claims 18-19 above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Canh Le whose telephone number is 571-270-1380.

The examiner can normally be reached on Monday to Friday 7:30AM to 5:00PM other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Canh Le  
January 26, 2008

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